



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

**Wood et al**

Serial No. **09/669,656**

Filed: **June 21, 1996**

For: **ION CHANNEL**

Atty. Ref.: **620-131**

Group: **1631**

Examiner: **Allen**

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Plunkett  
4/20/01  
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**APR 10 2001**

Technology Center 2600

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**APR 06 2001**

TECH CENTER 1600/2900

April 3, 2001

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

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**APR 17 2001**

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**RESPONSE**

Responsive to the Official Action dated November 3, 2000, entry and consideration of the following remarks are requested; the period for response having been extended up to and including April 3, 2001, by submission of the requisite petition and fee, attached.

Claims 8-10, 13, 14, and 17 to 33 are pending. Claims 9, 10, and 18 to 29 have been objected to on page 1 of the Office Action of November 3, 2000 (Paper No. 18), for no apparent reason. At a minimum, allowance of claims 9, 10, and 18 to 29 is requested. In the event these claims are rejected, a new non-final Office Action indicating the basis for the same is requested.

Claims 8, 13-14, 17 and 30-33 have been rejected under Section 112, first paragraph, for allegedly lacking written description support in the specification. Specifically, the Examiner relies on the "Revised Interim Written Description and Utility Guidelines" published in the Federal Register at Vol. 64, No. 244, pages 71427-71440,

Tuesday, December 21, 1999 "and corresponding training materials". See, page 2 of Paper No. 18. The applicants respectfully submit however that the "Revised Interim Guidelines" relied upon by the Examiner have been superseded by the attached "Guidelines for Examination of Patent Applications Under the 35 U.S.C. §112, ¶1, "Written Description" Requirement" published in the Federal Register at Vol. 66, No. 4, Friday, January 5, 2001.

The Examiner is understood to reject claims 8, 13-14, 17 and 30-33 because the Examiner believes the nucleic acid sequences are "not disclosed by the specification and thus the specification and claims fail to meet the written description provisions of 35 U.S.C. §112, first paragraph". See, page 2 of Paper No. 18. The applicants note however that while the interim guidelines relied upon by the Examiner may have supported her position, the attached Guidelines specifically indicate, for example, at comment 14, that

"if the amino acid sequence for a polypeptide whose utility has been identified is described, then the question of possession of a class of nucleotides encoding that polypeptide can be addressed as a relatively routine matter using the understanding of the genetic code ...".

The Patent Office incorporated this comment in the attached Guidelines and presumably edited the training materials to reflect the same, as noted in the attached at page 1102, left column, last full paragraph. This comment 14 and the Patent Office response supports the present applicants' position that the rejected claims 8, 13-14, 17 and 30-33 are supported by an enabling disclosure which adequately describes the

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claimed invention. Accordingly, withdrawal of the Section 112, first paragraph, rejection of claims 8, 13-14, 17 and 30-33, and allowance of all of the claims, are requested.

Moreover, the Examiner is requested to see comments 24, 7 and 9 in the attached which the applicants believe are also relevant to the Examiner's position, and the Patent Office's current representation of the law in this regard.

Consideration of the attached Information Disclosure Statement and return of an initialed copy of the attached PTO-1449 Form, pursuant to MPEP §609, are requested.

In view of the above and attached, the claims are submitted to be in condition for allowance and a Notice to that effect is requested.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_



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